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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/734,220 | 12/11/2000 | Marc W. Kauffman | D2487 | 5436 |
| 7590 | 06/01/2004 | | EXAMINER | |
| Wendy W. Koba, Esq. PO Box 556 Springtown, PA 18081 | | | DUONG, THOMAS | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2143 | |
| DATE MAILED: 06/01/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/734,220 | KAUFFMAN ET AL. |
| | Examiner Thomas Duong | Art Unit 2143 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 December 2000.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 May 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of *claim 1* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. Please provide drawings (such as state diagrams) showing the steps described in the specification. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
3. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Capek et al. (US006094677A).
4. With regard to claims 1 and 21, Capek reference discloses,

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- *a first cache (insertion repository 22) for storing a received alternative media file;* (Capek, col.7, lines 17-25, lines 39-47; module 22, fig.2; Capek teaches of an insertion repository that stores data (multimedia, advertisements, announcements, etc.) to be inserted in the data stream delivered to the requested client)
 - *a second cache (server 26) for storing a streaming multimedia file;* (Capek, col.7, lines 17-25; module 26, fig.2; Capek teaches of a server that stores data (multimedia, program material, etc.) to be delivered to the requested client)
 - *a control unit (insertion manager 20) for receiving as a first input a control signal from said first cache and generating as an output a switching control signal indicative of the presence or absence of a complete file being stored in said first cache; and* (Capek, col.7, lines 17-25, lines 39-47; module 20, fig.2; Capek teaches of an insertion manager that insert data (multimedia, advertisements, announcements, etc.) to be delivered to the requested client)
 - *a switching mechanism (control mechanism), responsive to said control unit switching output signal, said first cache and said second cache for providing as an output, directed to the at least one end-user, a stream selected one of" said first cache, said streaming multimedia file and said second cache, as controlled by said switching output signal from said control unit.* (Capek, col.9, lines 6-24; Capek teaches of a control mechanism that interact with and control the insertion of data (multimedia, advertisements, announcements, etc.) delivered to the requested client)
5. With regard to claims 2-3 and 22-23, Capek reference discloses,

- *wherein the control signal output from the first cache indicates that a complete alternative file is stored and is ready for transmission to the predetermined at least one end-user, or will be ready in time to transmit.* (Capek, col.7, lines 17-25, lines 39-47; Capek teaches of complete insertions of data to be delivered to the requested client)
6. With regard to claims 4-9, Capek reference discloses,
- *wherein the switching mechanism supplies as an output the streaming multimedia file in the absence of a signal from the control unit that an alternative file is ready to transmit.* (Capek, col.9, lines 6-24; Capek teaches of a control mechanism that interact with and control the insertion of data (multimedia, advertisements, announcements, etc.) delivered to the requested client)
7. With regard to claims 10-11, Capek reference discloses,
- *wherein the alternative file is defined as an advertisement file.* (Capek, col.7, lines 17-25, lines 39-47; col.7, line 66 – col.8, line 10; col.8, lines 11-14; Capek teaches of an insertion repository that stores data (multimedia, advertisements, announcements, etc.) to be inserted in the data stream delivered to the requested client)
8. With regard to claims 12-20, Capek reference discloses,
- *wherein the arrangement is disposed at a local point of presence in a communication network.* (Capek, col.7, lines 26-37)
9. With regard to claims 24-30, Capek reference discloses,
- *wherein in performing step d), switching from said streaming multimedia file to said alternative file when recognizing that an alternative file is available.* (Capek, col.9, lines 6-24; Capek teaches of a control mechanism that interact with and

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control the insertion of data (multimedia, advertisements, announcements, etc.)
delivered to the requested client)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - Merriman et al. (US005948061A)
 - Day et al. (US005996015A)
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 703/305-1886. The examiner can normally be reached on M-F 7:30AM - 4:00PM.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703/308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications.
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/305-3900.

Thomas Duong (AU2143)

May 17, 2004



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100